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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/884,854

Applicant(s)

ODINAK ET AL.

Examiner

Yogesh C. Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 19-54 and 65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 19-54 and 65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/1/2006 has been entered.

Response to Amendment

2. The Amendment, received on 12/1/2006, is acknowledged and entered. The applicant has amended claims 1, 10, 19, 27, 37, 44, 47, 48, 49 and 65. Claims 11-18 and 55-64 are previously withdrawn without traverse. Claims 1-10, 19-54 and 65 are pending for examination.

Response to Arguments

3. Applicant's arguments (see Remarks, pages 21-22) filed concerning rejection of claim 1 as being unpatentable over Crosby in view of Jackson have been fully considered but are not persuasive for the following reasons:

In response to the applicant's argument, "in the Jackson reference, the recording of a request is a pre-condition of receiving the song. Moreover, because the teachings of Jackson require the user to make a request before receiving the song/broadcast, the combination of teachings of Jackson with Crosby would render the Crosby system non-functional", the test for obviousness is not whether the features of a secondary reference may be bodily

Art Unit: 3625

incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Crosby teaches all the limitations of claim 1 including automatically presenting the content except for recording, after presenting the content, any requests made by a user based on the presented content and wirelessly transmitting the recorded requests to the server over the data network. In the same field of endeavor, that is providing on demand songs and video games via a wireless data network, Jackson explicitly teaches recording of requests and transmitting the recorded request wirelessly to a server in response to a selection made by the user from a displayed in crystal display window of a portable digital cellular device in automobile/home which is communicating with microwave cellular tower. Therefore it would be obvious to one of an ordinary skilled in the art to use the teachings of Jackson of recording requests and transmitting the recorded request wirelessly to a server in Crosby because it help the users of Crosby system, on receiving the desired information pertaining to digital musical songs or advertisements, to select and transmit that is record their requests for purchases via a mobile unit anywhere that is in a vehicle or home and would not make the Crosby's system non-functional.

Further, in response to applicant's argument that " in the Jackson reference, the recording of a request is a pre-condition of receiving the song. Moreover, because the teachings of Jackson require the user to make a request before receiving the song/broadcast, the combination of teachings of Jackson with of Crosby would render the Crosby system non-functional", the fact that applicant has recognized another advantage, that is of making a request before receiving the song/broadcast would flow naturally from following the suggestion

Art Unit: 3625

of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The Jackson's teachings of recording a request and transmitting the recorded request wirelessly to a server in Crosby can still be used.

In view of the foregoing, rejection of claim 1 and all other independent claims and their dependencies is sustainable over the already cited prior art in the Final rejection mailed on 6/20/2006.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10, 19-54 and 65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Currently amended claim 1 recites the limitation, "after receiving the radio broadcast and transmitting the content, recording at least one request made by a user based on the presented content, wherein the recording of the request is not required to receive the broadcast". This negative limitation was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's invention is directed to an interface which records a request after presenting a transmitted content based

upon a radio broadcast and this recorded request is used to purchase an item offered in the radio broadcast (see applicant's specification page 2, lines 22-25 and pg.3, lines 15-17) but the applicant's invention is neither directed nor suggests to a method or system implementing a manipulative step wherein the recording of the request is not required to receive the broadcast.

Since all currently amended independent claims include this limitation they also inherit the same deficiency and therefore all claims 1-10, 19-54 and 65 are rejected under 35 U.S.C. 112, first paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10, 19-54 and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Currently amended claim 1 recites the limitation, " after receiving the radio broadcast and transmitting the content, recording at least one request made by a user based on the presented content, wherein the recording of the request is not required to receive the broadcast". From the recitation of the claim it is clear that the recording of the request is done after receiving the transmitted content and the transmission of content is based upon the radio broadcast information then it is unclear why an additional manipulative step of "recording of the request is not required to receive the broadcast" is needed.

Since all currently amended independent claims include this limitation they also inherit the same deficiency and therefore all claims 1-10, 19-54 and 65 are rejected under 35

Art Unit: 3625

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Object to Specification

6. The amendment filed 12/1/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Currently amended claims 1-10, 19-54 and 65 recite the limitation, "after receiving the radio broadcast and transmitting the content, recording at least one request made by a user based on the presented content, wherein the recording of the request is not required to receive the broadcast". This negative limitation was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's invention is directed to an interface which records a request after presenting a transmitted content based upon a radio broadcast and this recorded request is used to purchase an item offered in the radio broadcast (see applicant's specification page 2, lines 22-25 and pg.3, lines 15-17) but the applicant's invention is neither directed nor suggests to a method or system implementing a manipulative step wherein the recording of the request is not required to receive the broadcast.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3625

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7.1. Claims 1-7,9-10,19-23,25-33-34, 36-40,42-51, 53-54 and 65 rejected under 35 U.S.C. 103(a) as being unpatentable over Crosby and further in view of Jackson (US Patent 6,516,466).

Regarding claims 1-7 and 9-10, Crosby teaches a method comprising:

receiving a radio broadcast at a vehicle, the vehicle having vehicle information; wirelessly transmitting content associated with the vehicle information from a server to the vehicle via a data network based on radio broadcast information associated with the received radio broadcast, **automatically presenting the content over a user interface after transmitting the content/after receiving the transmitted content**; processing at least one sent request wherein processing comprises generating a confirmation message upon completing a transaction based on the request; wirelessly transmitting the generated confirmation message over the data network and presenting the sent confirmation message over the user interface, further comprising wirelessly transmitting vehicle information- identifying vehicle location and direction of travel- from the vehicle to the server over the data network, wherein the content transmitted from the server to the user via a data network is based on radio broadcast information associated with the vehicle information includes at least one of the vehicle's location, trajectory, information requests, or transaction requests, wherein processing comprises: contacting a business system; and sending information from the business system to the server relating to the request, wherein the confirmation information comprises at least a portion of the information sent by the business system, and wherein the request is a request to purchase an item offered for purchase in one or more of the received radio broadcast or the sent content (see at least col.5, line 66-col.8, line 47, Quote:

Art Unit: 3625

" FIG. 1 illustrates an interactive radio network 100 wherein signals broadcast by land-based radio broadcasters 102 are received by interactive radio mobile units or mobile stations mounted within vehicles 104, with each mobile unit operated by a subscriber or other user (not separately shown.)

While listening to a radio broadcast, the subscribers transmit commands or other responsive signals from the mobile units via a communications satellite 106 to an interactive radio network ground station 108, which forwards the commands to an interactive radio network operations center 110. In response to commands received from the subscribers, the network operations center provides information feedback to the subscribers via the Internet 111, with the information being received at individual subscriber computers 112. In this manner, subscribers operating mobile units mounted within automobiles, trucks, planes, trains or the like, may request information pertaining to program segments broadcast by the various broadcasters, then review the information later via the Internet using home computers, work computers, personal digital assistants (PDAs) or the like. As one specific example, a subscriber selects individual songs of interest, then reviews information pertaining to the songs at a later time using his or her home computer[**Note the subscriber's computer such as PDA can provide a user**

interface for automatically presenting the content over a user interface at the

vehicle] . The subscriber thereby obtains information such as the song name and performer name for various musical selections of interest and, if desired, purchases any or all of the songs via e-commerce Internet sites accessible via the computer. In one other application, the system is configured to permit a subscriber to immediately enter a purchase order via the mobile unit, then review confirmation information via the Internet..... Each mobile unit includes a broadcast radio receiver and a wireless transmitter. The wireless transmitter is a satellite wireless communications device, which transmits signals via satellite 106 to interactive radio ground station 108. (Herein-below, alternative implementations utilizing cellular telephone base stations or dedicated localized communication systems are described.)The primary components of the mobile unit are illustrated in FIG. 2 and include a radio receiver 116, a GPS unit 118, a wireless satellite telephone transmitter 120 and a subscriber interface 122 for receiving control signals from an subscriber via one or more input

Art Unit: 3625

buttons or other input devices. The subscriber interface receives GPS coordinates from the GPS unit and receives radio broadcast signals from the radio receiver then, in response to commands entered by the subscriber, generates various interactive radio signals for transference to the wireless transmitter for transmission to the network operations center of FIG. 1. Referring again to FIG. 1, network operations center 110 processes the interactive radio signals transmitted by the mobile unit and generates appropriate feedback to the subscriber via the Internet. Next, the network operations center downloads information pertinent to the program segment and provides that information within a web site accessible by the subscriber, Thereafter, the subscriber may download the information from the web site into his or her computer or PDA by accessing the web site using the subscriber name and password. Alternatively, the network operations center maintains an e-mail address associated with the subscriber ID and transmits e-mail messages containing information corresponding to program segments selected by the subscriber via the designated e-mail address. In the example wherein the program segment selected by the subscriber is a musical selection, the network operations center provides information including the song title, CD title, In the example wherein the radio program segment selected by the subscriber is a radio advertisement, the network operations center provides information within a web page identifying the vendor and the specific goods or services offered for sale within the advertisement. ". Unquote. See also col.col.4, lines 42-45 and col.11, line 1-coi.12, line 11.).

Crosby, as analyzed above discloses transmitting and automatically presenting the content to the user based on a radio broadcast via a user interface, wherein the recording of the request is not required to receive the broadcast. Crosby does not disclose recording, after receiving the transmitted content based on a broadcast information, and wirelessly transmitting the recorded requests to the server over the data network . However, in the same field of endeavor, that is a method and apparatus for providing entertainment to a portable device in a vehicle, such as providing on demand digital data in form songs and video games to the users in an automobile, providing a list of available songs for display and selection on a

Art Unit: 3625

user's interface in the automobile (col. 1, line 30-col.2, line 25), Jackson suggests automatically presenting the content over a user interface at the vehicle or on a computer at home and recording any requests made by a user based on the presented content wirelessly transmitting the recorded requests to the server over the data network via "PCS"-Portable Cellular Stereo mounted in a vehicle. This "PCS" is either coupled to a car radio or designed to be part of the automobile radio system including a microwave cellular transmitter/receiver 36 coupled to a selection processor 38, LCD display screen 46 (see at least col.3, line 15-col.4, line 13). The "PCS" records the user's requests by speaking in a Voice recognition selection circuit 48 and then wirelessly transmits the recorded request to the server, that is microwave cellular tower 12 over the data network. In view of Jackson, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Crosby to incorporate Jackson's "PCS" features in the Crosby's invention, that is recording of requests after transmitting and automatically presenting the content to the user via a user interface based on the presented content and then wirelessly transmitting the recorded requests to the server over the data network. Doing so, as explicitly disclosed in Jackson, it would allow the Crosby's system to provide facilities for receiving multimedia content in the form of songs and videogames in the vehicle itself allowing users to send specific songs and videogames requests and avoiding carrying packages of disks of songs or games in person.

Regarding claims 4-7, Jackson teaches that presenting comprises at least a portion of the content or the message audibly, or displaying visually at least a portion -of the content or the message, recording comprises recording a phonation and processing request comprises performing voice recognition processing of the phonation, see Jackson at least

Art Unit: 3625

Fig.3, wherein it shows that the "PCS" includes a LCD with display screen 46 used for displaying the content and a voice recognition selection circuit 48 for recording a phonation and performing voice recognition processing of the phonation and a stereo/radio for presenting content audibly. In view of Jackson, it would have been obvious to one of an ordinary skill in the art at the time of the applicants Invention to have modified Crosby to incorporate Jackson's features of presenting a portion of the content or the message audibly, or displaying visually at least a portion of the content or the message, recording comprises recording a phonation and processing request comprises performing voice recognition processing of the phonation in the "PCS" in the vehicle, as explicitly disclosed in Jackson, because it would allow the system to provide convenience of receiving multimedia content in the vehicle on a display screen or audibly and recording and transmitting verbal song and videogame requests without using the hands.

Regarding system and apparatus claims, 19-23,25-33-34, 36-40, 42-51, 53-54, and 65, their limitations correspond to the Imitations of method claims 1-7, and 9-10 and are therefore analyzed and rejected based on the same rationale.

7.2. Claims 8, 24,35, 41, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crosby in view of Jackson, and further in view of Treyz et al. (US Patent 6,526,335 B1), hereinafter, referred to as Treyz.

Referring to claims 8, 24, 34, 41, and 52, Crosby in view of Jackson teaches a method, a system, and an apparatus, as disclosed in claims 1, 19, 27, 37, and 49 respectively and analyzed above. From the above analysis based on Crosby in view of Jackson, it is evident that the user in the vehicle is able to purchase products based upon the broadcast content.

Art Unit: 3625

Crosby in view of Jackson does not show, contacting a bank system to execute a monetary transfer based on user information and the request. However, in the field of same endeavor, that is using an interactive automobile personal computer system in a vehicle, Treyz teaches *contacting* a bank and executing a money transfer based on user information and request via a communication network (see at least. Figs 50 and 51 and col.45, line 9-col.46, fine 6, "At step 646, automobile personal computer 14 may communicate with the wireless device to authorize payment on behalf of the user. The payment may be for any suitable benefit, such as purchasing a product or service such as food Audible and visual techniques may be used to convey this information and to confirm that the transaction took place. Financial transactions may be involved in using automobile personal computer 14 to interact with wireless communications devices over remote and local wireless links." . " and col.71, lines 28-42, "Steps 1002 and 1004 may be implemented locally on automobile personal computer 14, may be implemented remotely (e.g., on a remote server that is in communication with automobile personal computer 14 over a remote wireless link such as a remote wireless Internet link or the like), **A benefit may be provided remotely by crediting the user's bank account.** ". In view of Treyz, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine Treyz's feature of contacting a bank and executing a money transfer based on user information and request via a communication network with Crosby/Jackson's interactive radio & "PCS" service system in a vehicle, because to allow the passengers in the vehicle to communicate with any other server including that of a bank and execute money transfer to close a purchase deal.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:


(i) Steele et al. (US Pg-Publication 2002/0046084A1, see paragraphs 0045-0063 and Figs 1-3) discloses a multimedia device 20 located in a vehicle receiving AM, FM and TV analog audio broadcasts via a Internet Gateway Network 30, wirelessly transmitting content from a server to the vehicle [see paragraphs 0059,0062 and 0063 wherein extended/enhanced information is transmitted from the Gateway network source computers, that is servers, associated with AM, FM and TV analog audio broadcasts including advertisements offering immediate purchase or additional information enabling an user in the vehicle to record a request for purchase or for additional information. This disclosure of Steel et al. renders obvious the limitations of claim 1 and other similar claims in the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
3/5/2007